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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,613	08/15/2000	John G. McBride	10971300-1	1686

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EXAMINER

TAT, BINH C

ART UNIT PAPER NUMBER

2825

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,613

Applicant(s)

MCBRIDE ET AL.

Examiner

Binh C. Tat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to application 09/639613 file on 08/15/00.

Claims 1-21 remain pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 8, 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, and 8 lines 3-5, the recitation of “said circuit configurations” is vague and confusing. The examiner could not make sense of “how many circuit configurations” is referred to in regards of the “circuit configuration to be indentified” as disclosed in line 3. Clarification is needed.

Regarding claim 15 lines 5-10, the recitation of “said circuit configurations” is vague and confusing. The examiner could not make sense of “how many circuit configurations” is referred to in regards of the “circuit configuration to be indentified” as disclosed in line 5. Clarification is needed.

Regarding claim 1, and 8 lines 3-5, the recitation of “^{any} probable circuit configurations” is vague and confusing. The examiner could not make sense of “how many probable circuit configurations” is referred to in regards of the “circuit configuration to be indentified” as disclosed in line 3. Clarification is needed.

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Regarding claim 15 lines 5-10, the recitation of ^{any} "probable circuit configurations" is vague and confusing. The examiner could not make sense of "how many probable circuit configurations" is referred to in regards of the "circuit configuration to be indentified" as disclosed in line 5. Clarification is needed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 (method), 8-14 (system), and 15-21 (readable-medium) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6249899 and claims 1-15 of U. S. Patent No 6484295 and claims 1-18 of U.S. Patent No. 6484296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the removal unnecessary steps in an invention is an obvious development in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Gould et al. (US Patent 5732246).
2. As to claims 1 (system), 8 (method), and 15 (computer readable storage medium) Gould et al. teach a method for identifying tri-state logic connected to a selected node of an integrated circuit by evaluating a netlist at the node comprising the step of: selecting a circuit configurations to be identified (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 45-54); identifying any of said circuit configurations at the node (see fig 7 and 11 and col 7 lines 45-54 and col 8 lines 22-44); and identifying any probable circuit configurations at the node (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 45-54 and col 8 lines 22-44).
3. As to claim 2, 9 and 16, Gould et al. teach wherein the step of selecting a circuit configuration includes identifying a complementary pass FET circuit configuration (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 55-65).
4. As to claim 3, 10 and 17, Gould et al. teach wherein the step of selecting a circuit configuration includes identifying a special complementary pass FET circuit configuration (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 55-65).

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5. As to claim 4, 11 and 18, Gould et al. teach wherein the step of selecting a circuit configuration includes identifying a gate output circuit configuration (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 55-65).

6. As to claim 5, 12 and 19, Gould et al. teach wherein the step of selecting a circuit configuration includes identifying a RAM cell circuit configuration (see col 11 lines 1-40).

7. As to claim 6, 13 and 20, Gould et al. teach wherein the step of selecting a circuit configuration includes identifying a feedback FET circuit configuration (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 55-65).

8. As to claim 7, 14 and 21, Gould et al. teach wherein the step of selecting a circuit configuration includes identifying a single pass FET circuit configuration (see fig 7 and 11 col 3 lines 39-46 and col 7 lines 55-65).

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Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh C. Tat whose telephone number is (703) 305-4855. The examiner can normally be reached on 7:30 - 4:00 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mathew Smith can be reached on (703) 308-1323. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Binh Tat
Art unit 2825
August 23, 2003



VUTHE SIEK
PRIMARY EXAMINER